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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 19

Application Number: 09/335,376

Filing Date: June 17, 1999

Appellant(s): Jae S. Lim

G. Roger Lee

For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief filed June 17, 2002 (December 13, 2002 C/M).

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Examiner did argue in the Final Rejection against applicant's attempt to traverse the Defective Reissue Declaration rejection (see paragraph 3), even though he did not explicitly repeat it therein.

(7) Grouping of Claims

The rejection of claims 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137, and 139-153 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

All of the new claims 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137, and 139-153 are rejected under 35 U.S.C. 251 as being an improper recapture of subject matter deliberately surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ289, 295 (Fed. Cir. 1984).

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The rejected claims are broader in an aspect germane to a prior art rejection by *failing to recite the identical or more narrow versions of at least one of the following limitations*, listed next (in paraphrased form) under the respective Patent and Application number pairs, *at least one of which* limitations was needed for the allowability of every one of the allowed independent claims in said, parent and related continuing, applications, as indicated by their prosecution history:

U.S. Patent 5,394,508 (appl. 07/822,247)

- Quantizing only once the magnitude of the yardstick signal element of each band, it being the signal element having the largest magnitude in the respective band {issued claims 1 and 13 ; original claim numbers 13 and 27, respectively} .
- More preferential bit allocation to a selected signal element if its location is between that of the yardstick signal element (defined, in general, as being of preselected size relative to the other signal elements in its band) and a selected end of the band, rather than being elsewhere {issued claim 8; original claim number 5} .
- Less accurate nonuniform quantization of a non-yardstick signal element, based on the sign of the yardstick element {issued claims 9 and 12; original claim numbers 7 and 22} .
- Specifying a plurality of non-yardstick signal element quantization levels to be within a range of less than the yardstick element magnitude if the yardstick element has positive amplitude; if negative, making the quantization level range less than twice said magnitude {issued claim 11; original claim number 12} .

- Specifying the location of respective yardstick signal elements with respect to at least one dimension within its band as well as the respective sign of the yardstick elements, and accurately quantizing said magnitudes, locations and signs for coding {issued claim 14; original claim number 41}.

U.S. Patent 5,369,724 (appl. 07/879,635)

- Having the magnitude of at least one of the yardstick signal elements (chosen on the basis of its preselected size relative to the other signal elements in its band) be closest to the median of the magnitudes of all the signal elements in its band {issued claim 1; original claim number 6}.
- Having the magnitude of at least one of the yardstick signal elements (chosen on the basis of its preselected size relative to the other signal elements in its band) be closest to the average of the magnitudes of all the signal elements in its band {issued claim 2; original claim number 7}.
- Two-stage quantization of at least one yardstick signal element, and encoding its magnitude and location within its band {issued claim 3; original claim number 8}.
- Quantizing a signal element (of preselected size relative to other signal elements therein) in a band (of preselected size relative to other signal elements therein) as a function of at least two yardstick signal elements {issued claim 4; original claim number 9}.
- Encoding the sign of at least one yardstick signal element for which the location has been encoded {issued claim 5; original claim number 10}.

- Quantizing the magnitude of at least one yardstick signal element for which the location was encoded and of at least one additional yardstick signal element, selecting a non-yardstick signal element in a band for which said location was encoded, allocating bits for the latter as a function of the quantized magnitudes of the at least two yardstick signal elements, the signal decoder translating the code based on said signal element bit allocation {issued claim 6; original claim number 12}.
- Encoding the location of at least one yardstick signal element with respect to its position along at least one dimension in which said signal elements are discrete within its respective band {issued claim 10; original claim number 16} .
- Quantizing the magnitudes of at least one yardstick signal element with encoded location and at least an additional yardstick element, selecting a non-yardstick signal element from the band containing encoded location yardstick and quantizing it as function of the quantized magnitudes of said at least two quantized yardsticks {issued claim 11; original claim number 19}.

U.S. Patent 5,640,486 (appl. 08/345,879)

- Coding of yardstick signal element location relative to the non-yardstick elements and sending that information with the encoded signal for decoding, further using the specific location data for perceptual coding and for decoding {from Indication of Allowable Subject Matter for issued claims 1, 6, 7, and 8 ; original claim numbers 1, 11, 17, and 18, respectively}

(11) Response to Argument

Applicant, after correctly noting examiner's surrender-by-argument basis for rejecting the new claims for improper recapture in the second Office Action, dismisses examiner's paraphrased list of limitations needed to make the various claims in the parent applications allowable as "a verbal slight [sic] of hand" (Appeal Brief, p. 3).

However, the limitations now being omitted or broadened in the present reissue were originally **presented/argued/stated** in the original application to make the claims allowable over a rejection or objection made in the original application. Thus, the omitted limitations relate to subject matter previously **surrendered** by applicant, and impermissible **recapture** exists. Details on how these limitations were presented or argued or stated during prosecution of the parent applications follow, addressing the now missing limitations from claims in the reissue application in the same order as given above:

U.S. Patent 5,394,508 (appl. 07/822,247)

- Quantizing only once is argued as basis for allowability of original claims 13 and 27 on pages 21 and 26 of Amendment A.
- More preferential bit allocation inclusion made original claim 5 allowable after it was amended (Amendment B, p. 1-3 and 10).

- Less accurate non-uniform quantization inclusion made original claims 7 and 22 allowable (Amendment B, p. 3-4, 7-8, and 11).
- Specifying a plurality of non-yardstick quantization levels inclusion made original claim 12 allowable (Amendment B, p. 5-7 and 11).
- Specifying the location of respective yardstick inclusion made original claim 41 allowable (Amendment B, p. 8-9 and 11).

U.S. Patent 5,369,724 (appl. 07/879,635)

- Having magnitude of at least one yardstick be closest to median inclusion made original claim 6 allowable (Amendment D, p. 1-2 and 11).
- Having magnitude of at least one yardstick be closest to average inclusion made original claim 7 allowable (Amendment D, p. 2-3 and 11).
- Two-stage quantization of at least one yardstick inclusion made original claim 8 allowable (Amendment D, p. 3-5 and 11).
- Quantizing a signal element as function of at least two yardsticks inclusion made original claim 9 allowable (Amendment D, p. 5-6 and 11).

- Encoding the sign of at least one yardstick inclusion made original claim 10 allowable (Amendment D, p. 6-7 and 11).
- Quantizing the magnitude of at least one yardstick for which etc. inclusion made original claim 12 allowable (Amendment D, p. 7-9 and 11).
- Encoding the location of at least one yardstick with respect to its position along at least one dimension amendment made original claim 16 allowable (Amendment A, p. 3-5).
- Quantizing the magnitudes of at least one yardstick with encoded location etc. inclusion made original claim 19 allowable (Amendment D, p. 9-10).

U.S. Patent 5,640,486 (appl. 08/345,879)

- Coding of yardstick signal element location relative to the non-yardstick elements and sending that information with the encoded signal for decoding, further using the specific location data for perceptual coding and for decoding, made original claims 1, 11, 17, and 18 allowable {see under Allowable Subject Matter in the Office Action of December 26, 1995, Paper No. 6}.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

May 10, 2006

Conferees

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